

REMARKS

Rejection of claims 1, 6-7, 9, 12, 16-17 and 19 under 35 U.S.C. §103(a) as being unpatentable over Tuoriniemi in view of Dias and Schwob

The Examiner rejected claims 1, 6-7, 9, 12, 16-17 and 19 under 35 U.S.C. §103(a) as being unpatentable over the combination of Tuoriniemi, Dias and Schwob. In the rejection of claims 1 and 12, the Examiner admits that Tuoriniemi and applicant's discussion of the prior art is silent on a display that displays information regarding at least one channel that is not selected wherein the displayed information is derived from the identifying information for the at least one channel that is not the selected channel. The Examiner then cites to the television channel map in Dias, cites to the radio broadcast receiver in Schwob, and states that it would have been obvious to one skilled in the art at the time of the invention to modify Tuoriniemi, such that the system displays at least one channel that is not selected, to provide means for a user to simultaneously listen to one station/song while viewing if there is another station/song they prefer to switch to.

Dias displays its channel map on a television. A television is a visual and audio medium. As such, it requires a screen to display the television images. Because a television inherently has a large display area on its screen, an online channel guide may be displayed on the same screen as discussed in Dias. A satellite radio receiver, in contrast, is a device for providing audio programming to a user. A display on known satellite radio receivers only provides information about the currently-selected channel. Displays on known satellite receivers have very limited display areas, as shown by FIG. 7 of Shigematsu. For this reason, it would not have been obvious to one of ordinary skill in the art to apply the principles of a TV channel guide in Dias to a satellite radio receiver, because satellite radio receivers typically have such a limited display area that display of the channel guide in Dias would be impossible.

It is useful to consider the state of the art in satellite television receivers, which typically provide a channel guide as taught in Dias. Applicants' attorney owns an EchoStar satellite television receiver for receiving satellite programming from DishNetwork. This satellite television receiver has a single green light emitting diode (LED) that indicates when the receiver is on. There is no display of any other information in the receiver. The only "display" is via a television coupled to the satellite television receiver. The combination of a satellite television receiver and an external television does not read on a display "within the satellite radio receiver", as expressly recited in the claims. Applicants respectfully assert that Dias expressly teaches away from a display on the satellite television receiver because it would never be needed when a television is coupled to a satellite television receiver. The TV would always serve as the display. Because satellite TV is both visual and audio, the visual display (TV) will always be present, making any sort of display that provides channel information on the satellite TV receiver itself redundant and unnecessarily costly.

The Examiner's liberal application of the teachings of channel guides for TVs to a satellite radio receiver ignores the fundamental differences between the two. Televisions are visual devices that require a large, detailed display screen to display TV programs. Because the screen is already present to display TV programs, the screen may also be used to display programming information, such as the channel guide in Dias. A satellite radio receiver, in contrast, is an audio device that outputs a selected audio program. A limited display is generally provided to display information regarding the currently selected audio program. Because satellite radio is an audio medium, one skilled in the art would not be motivated to incorporate a relatively large display into a satellite radio receiver to display a channel guide as taught in Dias. Note that the channel guide in Dias displays many channels, while the display shown in FIG. 4 of applicants' disclosure shows the display of only three non-selected channels. This limited display of a few non-selected channels would not be obvious in light of the teachings of channel guides for TVs as taught by Dias.

The Examiner cites to Schwob because Schwob teaches a radio broadcast receiver that has a screen that is larger than normal and has the capacity/size to display many different pieces of information at the same time. The radio receiver in Schwob displays more information than many traditional radio receivers, including date, time, alarm, sleep mode, type of music, city, and state. Note, however, that the display in Schwob only deals with the currently-selected station. Nowhere does Schwob teach or suggest that non-selected channels could be displayed.

The core issue is whether it would have been obvious to one of ordinary skill in art to provide a display within a satellite radio receiver that displays information regarding at least one channel that is not the selected channel based on the teachings of a visual channel guide in Dias. Applicants readily admit that Schwob teaches a display for a radio receiver that includes information not found in many prior art displays. However, the information on the Schwob display has nothing whatsoever to do with the display of information regarding one or more channels that are not the selected channel. Dias teaches a channel guide for a satellite television receiver that is displayed on a display (TV) that is separate from the satellite television receiver. Because the display in Dias used to display the channel guide is a separate TV, there is no need for such a display in the satellite television receiver of Dias. For these reasons, the combination of Tuoriniemi, Dias and Schwob does not render obvious claims 1, 6-7, 9, 12, 16-17 and 19 under 35 U.S.C. §103(a).

Applicants respectfully assert that the Examiner's rationale for combining Tuoriniemi, Dias and Schwob is improper. The Examiner states:

It would have been obvious to one skilled in the art at the time of the invention to modify Tuoriniemi, such that the system displays at least one channel that is not selected, to provide means for a user to simultaneously listen to one station/song while viewing if there is another station/song they prefer to switch to.

If we strip away the specific language the Examiner uses, the Examiner's rationale basically states that it would be obvious to modify Tuoriniemi with the channel guide taught in Dias and the display taught in Schwob to provide the advantages of the claimed invention. This is not a proper rationale for combining Tuoriniemi, Dias and Schwob. If an Examiner could establish obviousness by stating that a combination of references A, B and C would be obvious because of advantages only taught in the claims, the Examiner's job would be very simple, indeed. Nowhere does Tuoriniemi, Dias nor Schwob teach or suggest a display within a satellite radio receiver that displays information regarding at least one channel that is not the selected channel. There is no motivation in any of these references to support their combination. The only motivation resides in applicants' claims, which amounts to impermissible hindsight reconstruction. One skilled in the art looking at these three references would realize that a satellite radio receiver typically does not include a "screen" that is capable of displaying the online channel guide in Dias, and would therefore not be motivated to apply the teachings of Dias to Tuoriniemi and Schwob, as suggested by the Examiner. For these many reasons given above, applicants respectfully assert that the Examiner's rejection of claims 1, 6-7, 9, 12, 16-17 and 19 is improper, and respectfully request reconsideration of the Examiner's rejection of these claims under 35 U.S.C. §103(a).

Rejection of claim 2 under 35 U.S.C. §103(a) as being unpatentable over Tuoriniemi and Dias in view of Shigematsu

The Examiner rejected claim 2 under 35 U.S.C. §103(a) as being unpatentable over the combination of Tuoriniemi, Dias and Shigematsu. In rejecting claim 2, the Examiner states: "Tuoriniemi teaches claim 1 but is silent on further comprising memory coupled to the satellite radio processor, the memory containing at least one channel preset." This statement by the Examiner is incorrect. Tuoriniemi does not teach claim 1. The rejection of claim 1 relies upon the combination of Tuoriniemi, Dias and Schwob. Because Tuoriniemi alone does not teach claim 1, as asserted by the Examiner, the Examiner has failed to establish a prima facie case of obviousness for claim 2. Because claim 2 depends on claim 1, a proper rejection of claim 2 would have to include all of the references used to reject claim 1. Yet claim 2 is rejected based on the combination of Tuoriniemi, Dias and Shigematsu, without any reference to Schwob. Because the Examiner has not identified the proper references used as a basis for rejecting claim 2, the Examiner has failed to establish a prima facie case of obviousness for claim 2. In addition, claim 2 depends on claim 1, which is allowable for the reasons given above. As a result, claim 2 is also allowable as depending on an allowable independent claim.

Rejection of claims 3-4, 10-11, 13-14 and 20-21 under 35 U.S.C. §103(a) as being unpatentable over the combination of Tuoriniemi, Dias, Shigematsu, Yuen, Liebenow and Logan

The Examiner rejected claims 3-4, 10-11, 13-14 and 20-21 under 35 U.S.C. §103(a) as being unpatentable over the combination of Tuoriniemi, Dias, Shigematsu, Yuen, Liebenow and Logan. Each of these claims is addressed below.

Claims 3 and 13

In rejecting claims 3 and 13, the Examiner states: “Tuoriniemi teaches [sic] claim 2 but is silent on wherein the memory further contains a list of favorite channels, wherein the at least one channel that is not selected is in the list of favorite channels.” This statement by the Examiner is incorrect. Tuoriniemi does not teach claim 2. The rejection of claim 2 relies upon the combination of Tuoriniemi, Dias and Shigematsu, but even this is in error, because the rejection of claim 2 *should* rely upon the combination of Tuoriniemi, Dias, Schwob, and Shigematsu. Because Tuoriniemi alone does not teach claim 2, as asserted by the Examiner, the Examiner has failed to establish a *prima facie* case of obviousness for claims 3 and 13.

In the rejection, the Examiner states that Liebenow teaches a radio or television receiver where a user may specify a list of favorite channels or stations, and concludes that it would have been obvious based on the teachings of Liebenow to modify Tuoriniemi “such that the memory contains a favorites list, to provide means for the user to simultaneously listed to a radio program/song and view other program/songs available which may be among their favorites list.” Again, the Examiner’s rationale for combining Liebenow with Tuoriniemi is essentially so one would enjoy the benefits of the claimed invention. Neither Liebenow, Tuoriniemi, nor knowledge in the art teach or suggest the desirability of this combination absent the benefits outlined in the claims, which amounts

to impermissible hindsight reconstruction. For this reason, the combination of Liebenow with Tuoriniemi is improper. In addition, claim 3 depends on claim 2, which depends on claim 1, which is allowable for the reasons given above, and claim 13 depends on claim 12, which is allowable for the reasons given above. As a result, claims 3 and 13 are also allowable as depending on allowable independent claims. For the many reasons given above, applicants respectfully request reconsideration of the Examiner's rejection of claims 3 and 13 under 35 U.S.C. §103(a).

Claims 4 and 14

In rejecting claims 4 and 14, the Examiner states: "Tuoriniemi teaches [sic] claim 3 but is silent on wherein the list of favorite channels is at least partially defined by the at least one channel preset." This statement by the Examiner is incorrect. Tuoriniemi does not teach claim 3. The rejection of claim 3 relies upon the combination of Tuoriniemi, Dias, Schwob, Shigematsu, Yuen, and Liebenow. Because Tuoriniemi alone does not teach claim 3, as asserted by the Examiner, the Examiner has failed to establish a *prima facie* case of obviousness for claims 4 and 14.

In the rejection, the Examiner states that Yuen teaches that memory contains a favorite channel list that includes a list of channel identifiers, each channel identifier corresponding to one of a subset of the set of channels received by the tuner, citing the abstract of Yuen. The abstract of Yuen cited by the Examiner contains no reference to memory for storing favorite channels, and has no reference to channel identifiers. Yuen does teach in FIGS. 15 and 39 the display of channels according to the program that is currently playing on a channel. The filtered channel list of Yuen does not read on a list of favorite channels, as recited in claims 4 and 14. The channel guide for NBC will change from one category to another depending on the current program that is playing. For this reason, the filtered lists in Yuen do not read on the list of favorite channels recited in claims 4 and 14. Furthermore, the presets in claim 2 were supposedly disclosed in the

radio of Shigematsu, while the favorite channels were supposedly disclosed in the TV listing in Yuen. How could the TV listings in Yuen be defined by a radio preset in Shigematsu? They clearly can't. While Liebenow teaches a list of favorite channels or stations, it has no teaching that the list of favorite channels or stations is at least partially defined by the at least one channel preset.

The Examiner has combined SIX references to allegedly read on the limitations in claims 4 and 14. Yet, NONE of these SIX references teach that a list of favorite channels is at least partially defined by one or more channel presets. This is a feature that is found ONLY in applicants' claims. The Examiner glosses over this fact, stating:

It would have been obvious to one skilled in the art at the time of the invention to modify Tuoriniemi, such that the list of favorite channels is at least partially defined by the at least one channel preset, to provide means for one channel preset to bring up a listing of favorites that can be associated with that preset (eg. several JAZZ stations can be viewed based upon selecting that one channel preset button).

Again, the Examiner has engaged in impermissible hindsight reconstruction by stating that one would be motivated based on the combination of these SIX references to arrive at a feature (list of favorites at least partially defined by one or more channel presets) that is only contained in the claims, and that is not present in ANY of the SIX references. For this reason, the Examiner has failed to establish a prima facie case of obviousness for claims 4 and 14 under 35 U.S.C. §103(a).

Applicants respectfully submit that a list of favorite channels that is at least partially defined by at least one channel preset, as recited in claims 4 and 14, patentably distinguishes over the combination of Tuoriniemi, Dias, Schwob, Shigematsu, Yuen and Liebenow. In addition, claim 4 depends on claim 3, which depends on claim 2, which depends on claim 1, which is allowable for the reasons given above, and claim 14 depends on claim 13, which depends on claim 12, which is allowable for the reasons

given above. As a result, claims 4 and 14 are allowable as depending on allowable independent claims. For the many reasons given above, applicants respectfully request reconsideration of the Examiner's rejection of claims 4 and 14 under 35 U.S.C. §103(a).

Claims 10 and 20

Claims 10 and 20 are very detailed claims. The Examiner's attempt to combine SEVEN cited references to allegedly render obvious the detailed combination of features in claims 10 and 20 amounts to an attempt to pound a square peg into a round hole: it just doesn't fit. The Examiner has mixed and matched teachings of radio receivers with teachings of TV channel guides. As discussed above in detail with respect to the first claim set, one of ordinary skill in the art would not be motivated to apply the teachings of a TV channel guide to a display in a radio receiver.

In the rejection, the Examiner reads the radiotext of Tuoriniemi as reading on the display of time remaining. First of all, the transmission of radiotext provides information to the receiver that could be displayed, but Tuoriniemi has no explicit teaching of displaying the radiotext. Furthermore, claims 10 and 20 include the limitation of displaying time remaining for the radio program corresponding to the selected channel, and displaying time remaining for the radio program corresponding to the at least one channel that is not the selected channel. The Examiner cites to Logan as allegedly teaching the display of time remaining for a radio program. Note, however, that the Logan system is an audio program and message distribution system in which a host system organizes and transmits program segments to client subscriber locations. The host organizes the program segments by subject matter and creates scheduled programming in accordance with preferences associated with each subscriber. The Logan system thus does not deal with real-time broadcasts, such as satellite radio broadcasts, but instead compiles programs and delivers the programs to the consumer at the consumer's scheduled time. For this reason, the indication of time remaining in a recorded message

does not render obvious the display of time remaining for both the radio program corresponding to the selected channel and time remaining corresponding to the at least one channel that is not the selected channel. Even if Logan does read on displaying time remaining for the selected channel, it would not be obvious in light of Logan to display time remaining for the non-selected channels. NONE of the SEVEN cited references teach or suggest the display of time remaining for a selected radio program AND the display of time remaining for one or more non-selected radio programs. For this reason, claims 10 and 20 are allowable over the cited combination of Tuoriniemi, Dias, Schwob, Shigematsu, Yuen, Liebenow and Logan. Applicants respectfully request reconsideration of the Examiner's rejection of claims 10 and 20 under 35 U.S.C. §103(a).

Claims 11 and 21

Claim 11 depends on claim 10, which is allowable for the reasons given above. Claim 21 depends on claim 20, which is allowable for the reasons given above. As a result, claims 11 and 21 are allowable as depending on allowable independent claims, and applicants respectfully request reconsideration of the Examiner's rejection of claims 11 and 21 under 35 U.S.C. §103(a).

Rejection of claims 5 and 15 under 35 U.S.C. §103(a) as being unpatentable over the combination of Tuoriniemi, Dias, Shigematsu, Yuen, and Alexander

The Examiner rejected claims 5 and 15 under 35 U.S.C. §103(a) as being unpatentable over the combination of Tuoriniemi, Dias, Shigematsu, Yuen, and Alexander. In the rejection, the Examiner states: "Tuoriniemi teaches [sic] claim 3 but is silent on wherein the list of favorites is determined by the processor according to which channels are listened to most frequently." This statement by the Examiner is incorrect. Tuoriniemi does not teach claim 3. The rejection of claim 3 relies upon the combination of Tuoriniemi, Dias, Shigematsu, and Yuen, and should additionally rely upon Schwob, because Schwob was relied upon in the rejection of claim 1. Because Tuoriniemi alone does not teach claim 3, as asserted by the Examiner, the Examiner has failed to establish a *prima facie* case of obviousness for claims 5 and 15.

In the rejection, the Examiner states:

Alexander teaches a viewer profile which is based upon a person's viewing habits (eg. which shows they watch more frequently than others) and giving them a higher precedence over others in the viewing list AND/OR automatically tuning the TV to that show when it is on (C30, L45-67, see *Nick at Night* reference).

The Examiner then concludes that it would be obvious based on these teachings in Alexander to determine a list of favorites according to channels more frequently listened to. This logic forgets one very important point. Alexander does not decide which channels to include or exclude from a list based on which channels are watched more frequently than others. The only thing Alexander does is change the *position* of the channel in the list. Thus, more frequently watched channels could be placed higher on the list, while less frequently watched channels could be placed lower on the list. Nowhere does Alexander teach or suggest including frequently watched channels in a favorite list of channels that does not include all of the channels. For this reason,

Alexander does not read on the determining a list of favorites according to which channels are listened to most frequently. For these reasons, applicants respectfully assert that claims 5 and 15 are allowable over the combination of Tuoriniemi, Dias, Shigematsu, Yuen, and Alexander, and applicants respectfully request reconsideration of the Examiner's rejection of claims 5 and 15 under 35 U.S.C. §103(a).

Rejection of claims 8, 18 and 22 under 35 U.S.C. §103(a) as being unpatentable over the combination of Tuoriniemi, Dias and Alexander

The Examiner rejected claims 8, 18 and 22 under 35 U.S.C. §103(a) as being unpatentable over the combination of Tuoriniemi, Dias and Alexander.

Claims 8 and 18

In the rejection of claims 8 and 18, the Examiner states: "Tuoriniemi teaches [sic] claim 1 but is silent on wherein the displayed information includes time remaining for the radio program." This statement by the Examiner is incorrect. Tuoriniemi does not teach claim 1. The rejection of claim 1 relies upon the combination of Tuoriniemi, Dias and Schwob. Because Tuoriniemi alone does not teach claim 1, as asserted by the Examiner, the Examiner has failed to establish a *prima facie* case of obviousness for claims 8, 18 and 22 under 35 U.S.C. §103(a).

In the rejection, the Examiner states: "Tuoriniemi teaches radiotext that identifies music, name of performer, change of program, etc., where the examiner interprets "etc." to include time remaining." How very convenient. Absent an express teaching in the cited art, the Examiner takes a simple expression "etc." and reads that expression to include a feature that is only taught in the claims. This amounts to a **CLEAR** case of hindsight reconstruction. How would one skilled in the art be motivated to display time remaining based on the word "etc." in Tuoriniemi? Such a position is borderline ludicrous. Applicants forcefully assert that the word "etc." cannot substitute for a positive recitation or suggestion of the limitation in the claim.

The Examiner cites Logan as teaching the display of time remaining in the currently playing segment. The Examiner then states:

It would have been obvious to one skilled in the art at the time of the invention to modify Tuoriniemi, such that the displayed information includes time remaining, to provide means for the user to decide - based on time remaining - whether to keep listening to the station/song or to change the channel.

Again, the Examiner attempts to justify the combination of the two references based on advantages taught solely in the claims. Logan teaches the display of time remaining for a program. Note, however, that the "displayed information" in claim 8 refers to the "displayed information regarding at least one channel that is not the selected channel" in claim 1. Because Logan does not display time remaining for a non-selected channel, Logan cannot render obvious the limitations in claim 8, even when combined with the other cited references. The Examiner essentially states that it would be obvious based on Logan to provide means for the user to decide - based on time remaining - whether to keep listening to the station/song or to change the channel. However, the time remaining in claim 8 is time remaining for the displayed information, which corresponds to at least one non-selected channel. Thus, the Examiner's rationale for rejecting claim 8 is defective. *Nowhere has the Examiner asserted that it would be obvious based on Logan to display time remaining for non-selected stations.* The Examiner's rationale is based on allowing the user to decide based on time remaining for the selected station whether to keep listening to the station/song or to change the channel. This rationale does not address the limitation of displaying time remaining for radio programs on the non-selected channels. There is no teaching or suggestion in ANY of the cited references to support the display of time remaining for radio programs on non-selected channels. The only teaching of displaying time remaining for radio programs on non-selected channels is in the claims themselves. Hindsight reconstruction, pure and simple. Applicants forcefully assert that the combination of Tuoriniemi, Dias, Schwob and Alexander do not render obvious claims 8 and 18, and that these claims are therefore allowable over the cited art. In addition, claim 8 depends on claim 1, which is allowable for the reasons given above, and claim 18 depends on claim 12, which is likewise allowable. As a result, claims 8 and 18 are also allowable as depending on allowable independent claims.

Applicants respectfully request reconsideration of the Examiner's rejection of claims 8 and 18 under 35 U.S.C. §103(a).

Claim 22

The Examiner rejects claim 22 using language and rationale similar to the rejection of claims 5 and 15, addressed above. For the reasons given above with respect to claims 5 and 15, claim 22 is likewise allowable. In addition, claim 22 depends on claim 20, which is allowable for the reasons given above. As a result, claim 22 is also allowable as depending on an allowable independent claim. Applicants respectfully request reconsideration of the Examiner's rejection of claim 22 under 35 U.S.C. §103(a).

General Comments

All of the Examiner's rejections reek of hindsight reconstruction. The Federal Circuit has held:

To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher. In re Fine, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988)(quoting W.L. Gore & Assoc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 U.S.P.Q. 303, 312-13 (Fed. Cir. 1983)).

The Federal Circuit also held:

Care must be taken to avoid hindsight reconstruction by using "the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit." Grain Processing Corp. v. American Maize-Products Co., 840 F.2d 902, 907, 5 U.S.P.Q.2d 1788, 1792 (Fed. Cir. 1988)(quoting Orthopedic Equip. Co. v. United States, 702 F.2d 1005, 1012, 217 U.S.P.Q. 193, 199 (Fed. Cir. 1983)).

A detailed look at the rejections shows many features and combinations of features that are only disclosed in the claims, yet the Examiner has used the patent claims as a guide through the maze of prior art references, combining the right references in the right way so as to allegedly achieve the result of the claims. This amounts to impermissible hindsight reconstruction. This conclusion is bolstered by the fact that the Examiner has relied upon SEVEN different references in an attempt to show a combination for all of the limitation in applicants' claims. In the Request for Reconsideration filed on 04/16/03, Applicants challenged the Examiner to provide rationale for combining the references that is based on teachings of the references or knowledge in the art, not based on the desirability of the claimed invention. Yet the Examiner has not met applicants' challenge. Nowhere do ANY of the references nor ANY knowledge in the art teach or suggest the desirability of combining features of a TV channel guide with a radio display. For this reason, the pending claims are clearly allowable over the cited art.

Conclusion

In summary, none of the cited prior art, either alone or in combination, teach, support, or suggest the unique combination of features in applicants' claims presently on file. Therefore, applicants respectfully assert that all of applicants' claims are allowable. Such allowance at an early date is respectfully requested. The Examiner is invited to telephone the undersigned if this would in any way advance the prosecution of this case.

Respectfully submitted,

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